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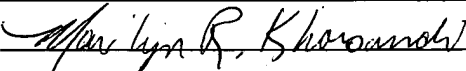
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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
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on March 7, 2006

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name Marilyn R. KhorsandiApplication Number
09/684010Filed
10/6/2000First Named Inventor
William W. Smith, III, et al.Art Unit
3629Examiner
Webb, Jamisue A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 45744☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____



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Telephone numberMarch 7, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Marilyn R. Khorsandi
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William W. Smith III, et al.
Application No. : 09/684,010
Filed : October 6, 2000
Title : Online, Multi-Carrier, Multi-Service Parcel Shipping
Management Functional Alignment of Computer Devices
Grp./Div. : 3629
Examiner : Webb, Jamisue A
Docket No. : PSTM0002/MRK

PRE-APPEAL BRIEF REQUEST FOR REVIEW REASONS

Mail Stop AF : 140 S. Lake Ave., Suite 312
Commissioner for Patents : Pasadena, CA 91101-4710
P.O. Box 1450 : March 7, 2006
Alexandria, VA 22313-1450

Commissioner:

In an Office Action dated December 7, 2005, a Final rejection, Claims 1, 3, 4 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,631,827; "Nicholls") in view of Robbins (Published U.S. Patent Application, Publication No. US 2005/0246359; "Robbins"); Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls and Robbins as applied to Claim 1, and further in view of Kara et al. (U.S. Patent No. 6,233,568; "Kara"), and Barnett (U.S. Patent No. 6,369,840; "Barnett"); Claims 7, 9, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls in view of Kara; Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls and Kara as applied to Claim 9, and further in view of Robbins. Claims 1-4, 6, 7, 9, 10 and 31 sometimes referred to herein collectively, as the "rejected Claims").

After carefully considering the rejections, this Request is filed pursuant to the guidelines for requesting a pre-appeal brief conference as presented in the Official Gazette (the "OG"), dated July 12, 2005. A pre-appeal brief panel review of the rejection of the rejected Claims is respectfully requested on grounds described in more detail below with reference to the Claims of the present application as amended in the Amendment and Response filed in response to the Office Action dated February 2, 2005. This Request is timely filed within the three-month period set by the Examiner

because it is filed before the expiration of March 7, 2006. Reconsideration and allowance of the application in view of this Request is respectfully requested.

A. ROBBINS IS NOT PRIOR ART

It is respectfully submitted that the earliest priority date (February 9, 2000) of the Robbins reference (a continuation application) does not pre-date either the October 6, 1999 filing date of U.S. Provisional Patent Application Serial No. 60/158,179 (the "'179 Application") or the December 10, 1999 filing date of U.S. Provisional Patent Application Serial No. 60/170,186 (the "'186 Application" to which, among others, the present application claims priority). Further, it is respectfully submitted that the '179 Application and the '186 Application disclosed all of the features for which the Robbins reference was cited and support the claims of the present application.

The specification of the '179 Application disclosed functionally aligned server computers and supports the Claims of the present application. See, e.g., the '179 Application, page 15, line 33 - page 17, line 4; FIG. 2a (including elements 10, 12, 13, 14, 15, 16). Further, the specification of the '179 Application, disclosed a tracking server and further supports the Claims of the present application. See, e.g., the '179 Application, page 16, lines 8 - 10; FIG. 2a, element 12.

Yet further, the specification of the '186 Application disclosed tracking features of an Internet-based shipping management system and yet further supports the Claims of the present application. See, e.g., the '186 Application, page 12, lines 6 - 23; page 16, lines 5 - 32; FIG. 3a (including elements 21a through 21n).

Because Robbins is not prior art, it is therefore respectfully submitted that the Office Action failed to show, as required under MPEP §2143, how the cited references, even when combined, disclose, anticipate, teach or suggest each of the limitations of each of Claims 1 (independent), 2-4 (dependent on Claim 1), 6 (independent), or 10 (dependent on Claim 9).

B. NO MPEP §706.02(i) PRIMA FACIE MOTIVATION TO COMBINE BARNETT

It is respectfully asserted that there is no teaching or suggestion, and that the rejections did not identify any teaching or suggestion, found in the prior art, as required under MPEP §706.02(j), to combine Barnett (regarding "*events belonging to different categories*"; see Barnett, col. 2, lines 26 - 29) with the other cited references with

respect to the subject matter of e.g., Claim 1 regarding "... rating each respective request ..." regarding a single event, i.e., "... to ship a respective parcel...". See also MPEP §2143.

C. NO SHOWING UNDER MPEP §2143 FOR EACH LIMITATION OF EACH CLAIM

It is respectfully asserted that the rejections did not indicate, as required under MPEP §2143, how the cited references, even when combined, disclose, anticipate, teach or suggest each of the limitations of each of the rejected Claims.

For example, Claim 2 of the present application recites limitations for which the rejection failed to indicate, as required under MPEP §2143, any disclosure, anticipation, teaching or suggesting by the cited references, even when combined. Claim 2 recites, among other things, a limitation to:

... generate a respective simultaneous cross-comparison display of respective shipping rates for each delivery service offered by each carrier of the plurality of carriers that would ship the respective parcel ...

It is respectfully submitted, for the reasons explained in more detail below, that the rejection failed to show that combining Barnett with the other cited references discloses, anticipates, teaches or suggests the above-cited limitation of Claim 2.

As compared to the above-quoted limitation of Claim 2, neither Nicholls nor Kara disclose, anticipate, teach or suggest "... generating a ... simultaneous cross-comparison display of respective shipping rates for each delivery service offered by each carrier of the plurality of carriers that would ship the respective parcel ...". Rather, as shown in, e.g., FIG. 4A of Nicholls, Nicholls discloses that either "...the service is selected [by the user] from the Service box ..." or that "...the service may be set to Best Way and the system will choose the least cost carrier which meets the transit time requirements indicated in the commitment field ...". See Nicholls, Col 7, lines 53-60.

Similar to Nicholls, Kara discloses a user pre-selection of a particular delivery service and a subsequent display of carrier-specific rates for the pre-selected delivery service adjacent to an identifier of the respective carrier. See, e.g., Kara, Figure 8A; Kara, col. 5, lines 56 – col. 6, line 6; Kara, col. 22, lines 21-48 (disclosing a "... program [that] automatically calculates the [shipping] fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters ...")

Kara, col. 22, lines 39 – 42 (emphasis added)). Therefore, according to Kara, a user of Kara must first indicate the desired shipping and/or delivery parameters (e.g., Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day) so that the Kara "program [will] automatically calculate[] the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters.*" Kara, col. 22, lines 39 – 42 (emphasis added). That is, only once a user has indicated a desired type of service, will the Kara program calculate the shipping rate for each carrier that supports *the desired service* and then display the results.

Importantly, as compared to the above-cited limitation of Claim 2, as can be seen in FIG. 8 of Kara, Kara would display only one rate per carrier at a time. In order to obtain a comparison of rates using Kara, it is respectfully submitted that a user would need to successively indicate an "urgency", e.g., "Overnight" on FIG. 8 of Kara, so that the Kara system would, according to the specification of Kara (e.g., Kara, col. 22, lines 39 – 42), calculate the rates for the shipping service providers (depicted in FIG. 8 of Kara as "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery") via each successively indicated "urgency".

Further, it is respectfully asserted that combining the Nicholls and/or Kara references with Barnett still does not disclose, anticipate, teach or suggest the above-recited limitations of Claim 2. Because, for the reasons described above, neither Nicholls nor Kara, whether considered alone or in combination, disclose, anticipate, teach or suggest the above-cited limitations of Claim 2, it is therefore respectfully submitted that combining the Nicholls and/or Kara with a calendaring system such as Barnett does not disclose, anticipate, teach or suggest the limitations to "... generate a respective simultaneous cross-comparison display of respective shipping rates for each delivery service offered by each carrier of the plurality of carriers that would ship the respective parcel ..." as recited in Claim 2.

Therefore, it is respectfully submitted that the rejection failed to indicate, as required under MPEP §2143, how Nicholls, Kara and/or Barnett, even when combined, disclose, anticipate, teach or suggest the above-recited limitation of Claim 2.

Yet further, for reasons similar to those described above regarding the rejection of Claim 2 with respect to Nicholls and Kara, it is respectfully asserted that Claim 7 of

the present application recites limitations for which the rejection failed to indicate, as required under MPEP §2143, any disclosure, anticipation, teaching or suggesting by the cited references, even when combined. For example, Claim 7 recites, among other things, limitations:

... to calculate a first respective shipping rate for a first carrier to ship the respective parcel via a first delivery service, to calculate a second respective shipping rate for a second carrier to ship the respective parcel via a second delivery service, and to calculate a third respective shipping rate for the first carrier to ship the respective parcel via a third delivery service... and
... to display the first respective shipping rate, the second respective shipping rate, and the third respective shipping rate ...

For reasons similar to those previously given above with respect to Claim 2, it is therefore respectfully submitted that the rejection failed to indicate, as required under MPEP §2143, how Nicholls, and/or Kara, even when combined, disclose, anticipate, teach or suggest the above-recited limitations of Claim 7.

Further still, for reasons similar to those described above regarding the rejection of Claim 7, it is respectfully asserted that the rejection failed to indicate, as required under MPEP §2143, how Nicholls, and/or Kara, even when combined, disclose, anticipate, teach or suggest similar limitations of Claims 9 or 31.

D. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

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